

REMARKS

A. 35 U.S.C. § 112, Second Paragraph

In the Office Action mailed on September 8, 2006, claims 19 and 20 were rejected under 35 U.S.C. §112, second paragraph, for being indefinite. In particular, claim 19 was rejected for lacking antecedent basis for “said diaphragm.” Claim 19 has been amended so as to depend from claim 16 instead of claim 6. Since there is proper antecedent basis for the phrase “said diaphragm”, the rejection has been overcome and should be withdrawn.

Since the amendment made to claim 19 is being made to correct an obvious typographical error, the amendment is not being made for reasons related to patentability as defined in *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 234 F.3d 558, 56 USPQ2d 1865 (Fed. Cir. 2000) (*en banc*), *overruled in part*, 535 U.S. 722 (2002) (hereinafter *Festo I*).

B. 35 U.S.C. § 102

1. Claims 1-8 and 11

Claims 1-8 and 11 were rejected under 35 U.S.C. §102(b) as being anticipated by Gordon et al. Claims 1, 3, 5 and 6 have been canceled rendering their rejections moot. Regarding the remaining claims, claims 2, 4, 7 and 11 have been amended so as to depend from either independent claim 9 or independent claim 12 and so the remaining claims 2, 4, 7, 8 and 11 depend directly or indirectly on claim 9 or claim 12. Since claims 9 and 12 have been indicated to contain allowable subject matter, their dependent claims 2, 4, 7, 8 and 11 should be allowable for at least the same reasons that claims 9 and 12 are allowable. Accordingly, the rejection has been overcome and should be withdrawn.

As mentioned above, claims 2, 4, 7 and 11 have been amended so as to depend from

independent claim 9 or independent claim 12. Since the amendments are being made solely to provide additional protection for either the scanning unit of claim 9 or the scanning unit of claim 12, the amendments are not being made for reasons related to patentability as defined in *Festo I*.

2. Claims 21-26

Claims 21-26 were rejected under 35 U.S.C. §102(b) as being anticipated by Gordon et al. Claims 21, 22 and 24-26 have been canceled rendering their rejections moot. Regarding the remaining claim, claim 23 has been amended so as to depend from independent claim 27. Since claim 27 has been indicated to contain allowable subject matter, its dependent claim 23 should be allowable for at least the same reasons that claim 27 is allowable. Accordingly, the rejection has been overcome and should be withdrawn.

As mentioned above, claim 23 has been amended so as to depend from independent claim 27. Since the amendment is being made solely to provide additional protection for the position measuring instrument of claim 27, the amendment is not being made for reasons related to patentability as defined in *Festo I*.

C. 35 U.S.C. § 103

1. Gordon et al. and Fujimoto et al.

a. Claims 14-17 and 19

Claims 14-17 and 19 were rejected under 35 U.S.C. §103 as being obvious in view of Gordon et al. and Fujimoto et al. Claims 14, 15 and 19 have been amended so as to depend from independent claim 9. Claims 16 and 17 depend indirectly on claim 12. Since claims 9 and 12 have been indicated to contain allowable subject matter, their dependent claims 14-17 and 19 should be allowable for at least the same reasons that claims 9 and 12 are allowable.

Accordingly, the rejection has been overcome and should be withdrawn.

As mentioned above, claims 14, 15 and 19 have been amended so as to depend from independent claim 9. Since the amendments are being made solely to provide additional protection for either the scanning unit of claim 9, the amendments are not being made for reasons related to patentability as defined in *Festo I*.

b. Claim 29

Claim 29 was rejected under 35 U.S.C. §103 as being obvious in view of Gordon et al. and Fujimoto et al. Claim 29 has been amended so as to depend from independent claim 27. Since claim 27 has been indicated to contain allowable subject matter, its dependent claim 29 should be allowable for at least the same reasons that claim 27 is allowable. Accordingly, the rejection has been overcome and should be withdrawn.

As mentioned above, claim 29 has been amended so as to depend from independent claim 27. Since the amendment is being made solely to provide additional protection for the position measuring instrument of claim 27, the amendment is not being made for reasons related to patentability as defined in *Festo I*.

2. Gordon et al., Fujimoto et al. and Bruni-Raimodi et al.

Claim 18 was rejected under 35 U.S.C. §103 as being obvious in view of Gordon et al., Fujimoto et al. and Bruni-Raimodi et al. Claim 18 depends indirectly on claim 12. Since claim 12 has been indicated to contain allowable subject matter, its dependent claim 18 should be allowable for at least the same reasons that claim 12 is allowable. Accordingly, the rejection has been overcome and should be withdrawn.

D. Claims 9, 10, 12, 13, 20, 27 and 28

Applicants note with appreciation that claims 9, 10, 12, 13, 20, 27 and 28 have been indicated to contain allowable subject matter. Claims 9, 12, 20, 27 and 28 have been amended so as to be in independent form. In addition, claim 10 has been amended so as to depend from claim 9. Accordingly, claims 9, 10, 12, 20, 27 and 28 and claim 13, which depends from claim 9, should be allowed.

As mentioned above, claim 10 has been amended so as to depend from independent claim 9. Since the amendment is being made solely to provide additional protection for the scanning unit of claim 9, the amendment is not being made for reasons related to patentability as defined in *Festo I*.

As mentioned above, claims 9, 12, 20, 27 and 28 have been amended so as to be in independent form. To the extent that the amendments incorporate subject matter that is inherently present in the previous versions of the claims, the amendments are not being made for reasons of patentability. See, *Festo Corporation v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd*, 535 U.S. 722 (2002).

E. New Claims 30-44

New claims 30-44 are being presented solely to provide additional coverage for either the scanning unit of claim 9 or the scanning unit of claim 12. Accordingly, the claims are being presented for reasons not related to patentability as defined in *Festo I*.

Note that claims 35 and 36 contain subject matter corresponding to that of claims 2 and 4, respectively. Claims 37-39, 30, 40-42, 31-33 and 43 contain subject matter corresponding to that of claims 9-19, respectively. Note that claims 34 and 44 each contain subject matter

corresponding to that of claim 20.

CONCLUSION

In view of the arguments above, Applicants respectfully submit that all of the pending claims 2, 4, 7-20, 23 and 27-44 are in condition for allowance and seek an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John C. Freeman", is written over a horizontal line.

John C. Freeman
Registration No. 34,483
Attorney for Applicants

BRINKS HOFER
GILSON & LIONE
P.O. Box 10395
Chicago, Illinois 60610
(312) 321-4200

Dated: December 8, 2006